

### REMARKS

#### DRAWINGS

In the Office Action, the drawings are objected to under 37 CFR § 1.83(a). Specifically, the objection states, "...the media being spaced above the return side inlet as recited in claims 1 and 5 must be shown or the feature(s) canceled from the claim(s)." Initially, the Applicant respectfully submits that the drawings merely illustrate one or a few embodiments of a multitude of possible embodiments of the invention. It is further submitted that the claims and figures are consistent with various, albeit different, embodiments of the invention. However, in the interest of furthering prosecution of the application, claims 1 and 5 have been amended to encompass embodiments of both the drawings and the original claims 1 and 5. Newly amended claims 1 and 5 recite, *inter alia*, an inlet operable to initially direct the return fluid below the filter media. It is believed that the amendments to claims 1 and 5 resolve the foregoing objection. Thus, the Applicant respectfully requests that the objection to the drawings under 37 CFR § 1.83(a) be withdrawn.

#### STATUS OF THE CLAIMS

Claims 1-35 are pending in the application. Claims 10-35 have been withdrawn from consideration by the Examiner. Claims 1 and 5 have been amended to resolve the 37 CFR § 1.83(a) objections, not for reasons substantially related to patentability. In this regard, the amendments to claims 1 and 5 encompass at least the media being spaced above the return side inlet, as previously claimed, and the media being spaced below the return side inlet, as illustrated in the drawings.

Support for these amendments is to be found at least on page 6, lines 11 and 12 and in FIG 4. Accordingly, no new matter has been added by these amendments and no estoppels are intended thereby.

### OFFICE ACTION

#### REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 1-9 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the rejection states, “[t]he specification fails to adequately disclose an embodiment including a return side inlet spaced above the inlet as recited in claims 1 and 5.”

The Applicant assumes a clerical omission was made in the Office Action and that the statement was intended to recite, “...has a return side inlet spaced above the filter media.” Based on this assumption, the Applicant respectfully submits that, as above, it is believed that the amendments to claims 1 and 5 resolves the foregoing rejection. Newly amended claims 1 and 5 recite, *inter alia*, an inlet operable to initially direct the return fluid below the filter media. It is to be noted that claims 1 and 5 have been amended to encompass embodiments of both the drawings and the original claims 1 and 5. In this regard, the amendments to claims 1 and 5 encompass, at least, the media being spaced above the return side inlet, as previously claimed, and the media being spaced below the return side inlet, as illustrated in the drawings. Specific support for these amendments is to be found at least on page 6, lines 11 and 12 and in FIG 4. Accordingly, no new matter has been added by these amendments. Thus, the Applicant respectfully requests the

reconsideration and withdrawal of the rejection of claims 1-9 under 35 U.S.C. §112, first paragraph.

#### REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-9 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. This rejection is respectfully traversed. The Applicant respectfully requests reconsideration and withdrawal of the rejection with respect to claims 1 and 5 and those claims that depend therefrom in view of the following remarks.

More specifically, with regards to claim 1, it is alleged that, "it is unclear as to how the 'inlet' and 'outlet' are formed..." The newly amended claim 1 recites, *inter alia*, an inlet operable to initially direct the return fluid below the filter media and an outlet located above the filter media and operable to release the return fluid. The Applicant believes these elements are clearly defined in terms of their respective functions. In this regard and according to M.P.E.P. 2173.05(g), "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." Quoting *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), M.P.E.P. 2173.05(g) further recites, "...the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly." The Applicant respectfully submits that claim 1 and the claims that depend therefrom are definite and adequately supported by the specification. In view of the foregoing, the Applicant respectfully requests withdrawal of the rejection to claim 1 and the claims that depend therefrom under 35 U.S.C. § 112, second paragraph.

Regarding claim 5, the Office Action alleges that, "it is unclear as to how the 'sump', 'sump inlet', 'return side inlet', and 'outlet' are formed since structure for forming sump, sump inlet, return side inlet, and outlet has been recited in the claim." The Applicant assumes a clerical omission was made in the Office Action and that the statement was intended to recite, "...has not been recited in the claim." Based on this assumption, the Applicant respectfully submits that, as above, these elements are clearly defined in terms of their respective functions. More specifically, with regard to the sump and sump inlet, newly amended claim 5 recites, *inter alia*, a sump operable to receive the fluid via a sump inlet. With regard to the return side inlet, newly amended claim 5 recites, *inter alia*, an return side inlet coupled with the sump inlet and operable to direct the return fluid into the pan. With respect to the outlet, newly amended claim 5 recites, *inter alia*, an outlet located above the filter media and operable to release the return fluid. As these elements are clearly defined in terms of their respective functions, the Applicant respectfully submits that claim 5 and the claims that depend therefrom are definite and adequately supported by the specification. In view of the foregoing, the Applicant respectfully requests withdrawal of the rejection to claim 5 and the claims that depend therefrom under 35 U.S.C. § 112, second paragraph.

Concerning claims 1 and 5, the Office Action alleges that, "it is unclear as to what extent 'at least substantially spanning the pan' implies." It is believed that the amendments to claims 1 and 5 obviate the foregoing rejection. Newly amended claims 1 and 5 recite, *inter alia*, a filter media spaced above the bottom surface and substantially spanning the pan. In view of the amendments to claims 1 and 5, the Applicant believes claims 1 and 5 are definite. In this regard, M.P.E.P. 2173.05(b)(D) clearly indicates that the term "substantially" in conjunction with another term is definite. In view of the foregoing, the Applicant respectfully requests withdrawal

of the rejection to claims 1 and 5 and the claims that depend therefrom under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 U.S.C. § 102(b) (U.S. Patent No. 3,371,793 to F. Robert J. Fowler)

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,371,793 to F. Robert J. Fowler (Fowler). The Applicant respectfully traverses this rejection. The Applicant submits that the invention as recited in claims 1 and 5 is patentably distinct from Fowler and thus, respectfully requests reconsideration and withdrawal of the rejection to claims 1 and 5 and the claims that depend therefrom.

Claims 1 and 5 recite, *inter alia*, an inlet operable to initially direct the return fluid below the filter media. In contrast, Fowler is directed to a filter device comprising an envelope of porous filter material having an aperture and a port configured to direct the flow oil through the aperture and into the interior of the envelope (see claim 1, FIG: 1, 3, 4, 6, Abstract, and Column 2 lines 14-21). In this regard, as Fowler is directed to an envelope, to filter the fluid, the fluid must move from the interior to the exterior of the envelope. More to the point, if the inlet of the filter device according to Fowler did direct fluid below the filter media i.e., under the envelope, it is unlikely it would function as there would be no force motivating the fluid through the envelope. Rather, if the fluid were to flow under the envelope the fluid would, most likely, proceed to flow around the bag and back into the transmission unfiltered. As such, Fowler fails to disclose directing the return fluid below the filter media.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection to claims 1 and 5 as being anticipated by Fowler is respectfully requested at least because Fowler fails to disclose directing the return fluid below the filter media. Claims 2-4 depend from independent claim 1

and claims 6-9 depend from independent claim 5. Therefore it is respectfully submitted that claims 2-4 and 6-9 are patentable for at least the same reasons as discussed in response to the rejection of claims 1 and 5 as being anticipated by Fowler. In light of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-4 and 6-9 as being anticipated by Fowler is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102(b) (U.S. Patent No. 2,809,754 to Alex Pudlo)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,809,754 to Alex Pudlo (Pudlo). The Applicant respectfully traverses this rejection. The Applicant submits that the invention as recited in claim 1 is patentably distinct from Pudlo and thus, respectfully requests reconsideration and withdrawal of the rejection to claim 1 and the claims that depend therefrom.

Newly amended claims 1 recites, *inter alia*, an inlet operable to initially direct the return fluid below the filter media. In contrast, in Pudlo it is an object of the invention to, "provide a filter construction which is so worked out that the liquid must pass through the pad twice..." (see Column 1 lines 34-37). To this end, Pudlo is directed to filtering a fluid first through one side of the filter and then a second time through the same filter (see Column 2 lines 42-45 and the claim). In this regard, as shown in FIG. 3, Pudlo is directed to a radial duct 16 configured to initially direct the flow of fluid on to the top of the filter pad 34. As such, Pudlo fails to disclose initially directing the return fluid below the filter media and, in point of fact, is directed to the opposite.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection to claim 1 as being anticipated by Pudlo is respectfully requested at least because Pudlo fails to disclose

directing the return fluid below the filter media. Claims 2-4 depend from independent claim 1. Therefore it is respectfully submitted that claims 2-4 are patentable for at least the same reasons as discussed in response to the rejection of claim 1 as being anticipated by Pudlo. In light of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-4 as being anticipated by Pudlo is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102(b) (Beer et al document)

Claims 1, 3-5, and 7-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by a French document 2,764,636 to Markus Beer and Ken Nelson (Beer et al). The Applicant respectfully traverses this rejection. The Applicant submits that the invention as recited in claims 1 and 5 is patentably distinct from the Beer et al document and thus, respectfully requests reconsideration and withdrawal of the rejection to claims 1 and 5 and the claims that depend therefrom.

Initially, the Applicant respectfully requests that an English translation of the Beer et al document be provided in order to more fully distinguish the present invention. However, in the interest of expediting the prosecution of this Patent Application, the Applicant submits the following based upon the English summary and figures. Claims 1 and 5 recite, *inter alia*, an outlet located above the filter media and operable to release the return fluid. The Office Action describes, "an outlet 108 located above the filter media and operable to release the return fluid." In point of fact, this is not the case, but rather, the element 108 is configured to receive fluid that has leaked out of the transmission (see FIG. 1). Thus, the element 108 is not an outlet, but rather, an inlet. As such, the Beer et al document fails to disclose an outlet located above the filter media and operable to release the return fluid.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection to claims 1 and 5 as being anticipated by the Beer et al document is respectfully requested at least because the Beer et al document fails to disclose an outlet located above the filter media and operable to release the return fluid. Claims 2-4 depend from independent claim 1 and claims 6-9 depend from independent claim 5. Therefore it is respectfully submitted that claims 2-4 and 6-9 are patentable for at least the same reasons as discussed in response to the rejection of claims 1 and 5 as being anticipated by the Beer et al document. In light of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-4 and 6-9 as being anticipated by the Beer et al document is respectfully requested.

#### REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 2 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Beer et al document in view of Pudlo. As claims 2 and 6 respectively depend from independent claims 1 and 5 and as the Applicant believes that claims 1 and 5 are allowable for at least the reasons recited herein, the Applicant respectfully submits that the rejection under 35 U.S.C. § 103(a) to claims 2 and 6 are moot. Thus, the Applicant respectfully requests reconsideration and withdrawal of the rejection to claims 2 and 6. However, in the interest of being complete, the Applicant submits that the invention as recited in claims 2 and 6 is patentably distinct from either the Beer et al document or Pudlo and any combination thereof. Thus, the Applicant respectfully requests reconsideration and withdrawal of the rejection to claims 2 and 6 in light of the following comments.

Claims 2 and 6 recite, *inter alia*, an inlet operable to initially direct the return fluid below the filter media. In contrast and as described herein Pudlo does not disclose an inlet operable to



initially direct the return fluid below the filter media. In addition, the Beer et al document does not disclose an inlet operable to initially direct the return fluid below the filter media. In this regard, the Beer et al document is directed to an inlet 111 configured to direct flow into a filter cartridge 101 (see Basic Abstract and FIGS 1-5). This filter cartridge 101 includes a circular housing having openings along the outer edge. Apparently, filter media encircles the inside of the outer edge and fluid is filtered as it passes through the openings (again see FIGS 1-5).

Therefore, the Beer et al document is directed to an inlet 111 configured to direct flow into the same plane as the filter media. As such, the Beer et al document fails to disclose directing the return fluid below the filter media. With regard to the filter element 105, the Beer et al document is directed to an inlet 108 configured to direct fluid (that has leaked from the transmission) down on to the filter element 105 (see Basic-Abstract and FIG 1). Therefore, the inlet 108 does not initially direct fluid below the filter element 105 and moreover, the inlet 108 does not direct the movement of return fluid. As such, neither the Beer et al document nor Pudlo taken alone or in combination disclose an inlet operable to initially direct the return fluid below the filter media.

In this regard and as stated in M.P.E.P. 706.02(j), "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." As neither the Beer et al document nor Pudlo taken alone or in combination disclose an inlet operable to initially direct the return fluid below the filter media, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Therefore, the Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) to claims 2 and 6.

It is respectfully submitted that the application is now in condition for allowance. If it is believed that any further issue exists, the Examiner is invited to contact the undersigned agent by telephone if it is believed that such contact will expedite the prosecution of the application.

In the event this response is not timely received or an extension is required, the Applicant petitions for an appropriate extension of time. Any additional fees may be charged to or overpayment credited to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP



Michael D. Graham  
Patent Agent  
Reg. No. 51,750

Date: June 3, 2003  
1050 Connecticut Avenue, NW, Suite 1100  
Washington, DC 20036  
Phone: (202) 860-1500  
Fax: (202) 861-1783

**APPENDIX**

**VERSION WITH MARKINGS SHOWING CHANGES MADE**

**IN THE CLAIMS:**

The claims are amended as follows.

1. (Amended) A return-side filter for filtering a return fluid in a vehicle transmission, the return-side filter comprising:

a pan having a bottom surface;

~~an inlet operable to direct the return fluid into the pan;~~

a filter media spaced above the bottom surface and ~~the inlet and at least~~ substantially spanning the pan and ~~operable to filter the return fluid; and~~

an inlet operable to initially direct the return fluid below the filter media; and

an outlet located above the filter media and operable to release the return fluid, wherein the filter media is operable to filter fluid flowing from the inlet to the outlet.

5. (Amended) A vehicle transmission utilizing a fluid, the vehicle transmission comprising:

a sump operable to receive the fluid via a sump inlet;

a return-side filter operable to filter at least a return fluid portion of the fluid, the return-side filter including:

a pan having a bottom surface;

~~an return-side inlet coupled with the sump inlet and operable to direct the return fluid into the pan;~~

a filter media spaced above the bottom surface and ~~the return-side inlet and at least substantially spanning the pan and operable to filter the return fluid; and~~

a return-side inlet coupled with the sump inlet and operable to initially direct the return fluid below the filter media; and

an outlet located above the filter media and operable to release the return fluid  
wherein, the filter media is operable to filter fluid flowing from the return-side inlet to the outlet.